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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,375	09/13/2000	Hannes Eberle	23453-020	8034

29315 7590 09/05/2003

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RESTON, VA 20190

EXAMINER

SMITS, TALIVALDIS IVARS

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 09/05/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/661,375

Applicant(s)
Hannes Eberle et al.

Examiner
Talivaldis Ivars Smits

Art Unit
2655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 4, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) 9-18 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 19, 20, and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. In response to the Office Action mailed March 4, 2003 applicants have submitted an Amendment, filed June 4, 2003, amending the Specification and claims 1, 7, 19, 20, and 23-26, without adding new matter, arguing for the allowability of the amended claims, and canceling claims 9-18 and 21. Applicants also amended drawings of Figures 3a, 3b, and 6b, and submitted an Information Disclosure Statement along with three boxes of publications listed on a 18 page Form PTO-1440.

Response to Arguments

2. Applicant's arguments with respect to amended claims 1 and 19 have been considered but are moot in view of the new ground(s) of rejection, replacing the Nakatsu *et al.* reference by U.S. Patent 6,389,398 of Paul C. Lustgarten *et al.* in the instant Office Action.

Claim Rejections - 35 USC § 103

3. The text of the section of Title 35, U.S. Code not included in this action can be found in the previous Office Action.

4. Claims 1-8, 19, 20, and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over David Ladd *et al.* (U.S. Patent 6,269,336, filed October 2, 1998) in view of Paul C.

Lustgarten (U.S. Patent 6,3889,398, filed June 23, 1999)

As per **claims 1-4, 6, 7, 19, and 22-25**, Ladd *et al.* teach establishing a communication channel, accessing a markup language document to parse the text for control of interactive voice service, and to deliver information via speech generated from text over a communication channel (col. 15, line 65 through col. 16, line 17).

Ladd *et al.* do not teach nor fairly suggest, but Lustgarten teach automatically initiating an interactive voice broadcast delivering personalized information based on the user preferences for the content and presentation format (scheduling a specific time to deliver the interactive voice service to a recipient based on stored queries, col. 2, lines 46-48; col. 3, lines 16-20 and 43-46 with col. 4, lines 6-9), determining whether the communication channel is established with a person or device, receiving responses from the intended recipient after delivering the generated speech, and accessing additional text based on the responses (implied by executing stored queries in an intelligent fashion, col. 2, line 66 through col. 3, line 16).

It would have been obvious for an artisan at the time of invention to add an automatic voice broadcast capability to Ladd *et al.*'s interactive voice service, because of the convenience of accomplishing Ladd *et al.*'s update information delivery goals (col. 2, lines 50-54) automatically rather than manually

As per **claim 5**, Ladd *et al.* teach using a version of a TML document for their dialogue system (see the discussion of their markup language in col. 16, line 21 through col. 43, line 53).

As per **claims 8 and 26**, neither Ladd *et al.* nor Lustgarten *et al.* explicitly teach validating the markup language document. However, an artisan at the time of invention would

have known that it is necessary to validate said document to avoid problems in the execution of the voice dialogue sequence or voice prompts and input interpretation.

As per **claim 20**, Ladd *et al.* suggest storing responses received from the intended recipient (*e.g.*, in col. 27, lines 10-14).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1 and 19 are rejected under the judicially created doctrine of obviousness-type

double patenting as being unpatentable over claims 1, 6, 8-14, 31, 33, and 36-42 of U.S. Patent No. 6,263,051 in view of Ladd *et al.* and Lustgarten *et al.* Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims are obtained by adding the elements discussed in the art rejections, above, to the patented claims.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. **Any response to this action should be mailed to:**

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

or FAXed to:

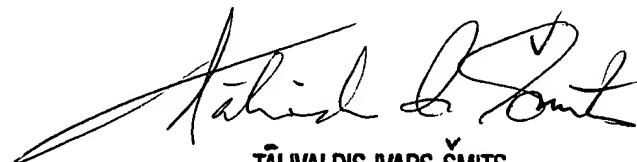
(703) 872-9314 (please label *official* communications
"EXPEDITED PROCEDURE"; please label *informal* or
draft communications "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive,
Arlington, VA, Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Talivaldis Ivars Smits, whose telephone number is (703) 306-3011. The examiner can normally be reached Mondays-Fridays from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor for examiner's new Art Unit 2655 (starting June 29, 2003), Doris H. To, can be reached on (703) 305-4827. The facsimile phone number for Technology Center 2600 is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 customer service, whose telephone number is (703) 306-0377.



TĀLIVALDIS IVARS ŠMITS
PRIMARY EXAMINER